

REMARKS

Applicants have carefully reviewed the contents of the Office Action mailed November 1, 2004. Reconsideration is respectfully requested in view of the foregoing amendments.

By this Amendment, the specification is amended to refer to “insertion drum/wobble drum” 16 for consistency with the rest of the specification, and new claim 27 is presented that positively states the sleeve element is pulled out of the first filter segment. Non-elected claims 17-26 are canceled without prejudice to the filing of a divisional application. Accordingly, claims 1-16 and 27 are pending in the instant application.

Claims 1-3, 5, and 10-16 were rejected under 35 U.S.C. § 102(a) as being anticipated by European Patent Application No. EP 1 226 765 to Heitmann et al. (hereinafter referred to as “Heitmann”) for the reasons set forth on pages 2-3 of the Action. Claims 4 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Heitmann as explained on page 4 of the Action. These rejections are respectfully traversed.

The claimed invention is directed to a method for producing multi-segment filter elements in the tobacco-processing industry, wherein the multi-segment filter elements each include a first filter segment (e.g., a cut filter segment) and at least one second filter segment (e.g., a hard or non-cuttable filter segment). As explained in the Background of the Invention, it is important that sensitive hard filter segments be handled and conveyed with extreme care during the filter production. The claimed invention achieves with the method including the following: 1) arranging a sleeve element (5) in the first filter

segment (1); 2) inserting the second filter segment (2) **into** the sleeve element (5) **in** the first filter segment (1); and 3) **pulling the sleeve element (5) out** of the first filter segment. Figures 2d-e and paragraph 0048 of the present application illustrate and describe the recited method, respectively. For example, sleeve element (5) is inserted **into** first filter segment (1) when a mandrel (3) piercing filter segment (1) and sleeve element (5) are jointly moved back “so that the sleeve 5 is inserted into the first filter segment 1 and forms a cavity with a solid wall in the first filter segment.” As further explained in paragraph 0048 of the present application, a pusher 33 then inserts the second filter segment 2 inside the sleeve 5, which is inserted in filter segment (1). Finally, the sleeve element (5) is removed or pulled out from filter segment (1), as shown in Figures 2f and 2g of the present application.

Heitmann is directed to a different method of producing a compound filter. EP 1 266 765 corresponds to U.S. Patent Application No. 10/058,200, which was published as US2002/0119874. While the Action states that “a sleeve element (Fig. 4; via 22-24) [is arranged] in the first filter segment (Fig. 4; via 20)”, the corresponding English language description clearly indicates that nothing is conveyed via reference numerals 22-24 of Heitmann, except plug 20 and push rod 17. In particular, Figure 4 of Heitmann illustrates pushers 23-24 with bores 14 where pusher 23 is moved to the left and an upper portion of plug 20 is vertically aligned with another bore 14 of pusher 23. In another operation, push rod 17 moves an additional filter plug 30, into a tube 11 that is located beneath pushers 23-24. That is, Heitmann does **not** arrange a sleeve element **in** the first filter segment. To the contrary, Heitmann discloses the filter plug 20 being arranged above a tube 11. If reference elements 22 and/or 23 is considered “a sleeve element” as alluded to in the first

full and third paragraphs of the Action, these so-called “sleeves” are **not** inserted **in** the filter plug 20. Instead, the so-called “sleeves” 22 and/or 23 of Heitmann are inserted with a plug 20. This is the opposite method of the recited invention. Accordingly, Heitmann fails to disclose the first method of arranging a sleeve element **in** the first filter segment. Consequently, Heitmann cannot anticipate the claimed invention as it fails to disclose each and every claimed feature.

The Action refers to Figure 7 that shows more than one filter material within a tube 11 as meeting the recited method of “inserting the second filter segment into the sleeve element in the first filter segment”. The pushers 23-24 are located above the tube 11. Thus, pushers 23-24 are never arranged in the first filter segment as argued above. Further, the second filter segment is recited as being inserted into the sleeve element in the first filter segment. Since the so-called “sleeves” are never inserted into a filter material, the second recited feature cannot be disclosed by Heitmann. As stated above, reference numerals 22-24 provide bores or opening through which filter material and a push rod extend. Nowhere does Heitmann disclose a “sleeve element” that is inserted within a first filter segment and then a second filter segment being inserted into the sleeve element in the first filter segment. On the contrary, Heitmann discloses apparatus for pushing filter material through pushers 22-24 and into a tube 11 to form a compound filter. The pushers 22-24 are not inserted into the tube 11 of Heitmann and thus, Heitmann fails to disclose the first and second recited features of claim 1.

Finally, the recited method pulls the inserted sleeve element out of the first filter segment. Since the so-called “sleeves” of the Action were never inserted into a filter material (as the filter material is inserted into bores of pushers 22-24), Heitmann fails to

disclose this feature of claim 1, as well. Accordingly, it is respectfully submitted that 35 U.S.C. §102 rejection of claims 1-3, 4, and 10-16 be withdrawn.

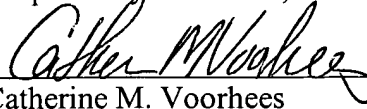
Dependent claims 4 and 6 are at least patentable for the reasons set forth above. In addition, it is respectfully submitted that one of ordinary skill in the art would not have modified the method and arrangement for producing compound filters taught by Heitmann to change its premise: inserting varying filter materials into a tube via a push rod 17. Nowhere does Heitmann address the problems associated with sensitive hard filters, nor does Heitmann teach or suggest arranging a sleeve element within a first filter segment and then inserting a second filter segment into the sleeve element in the first filter segment and then removing the sleeve element from the first filter element as claimed by Applicants. Thus, it is respectfully submitted that there is no motivation to modify Heitmann's differing compound producing method. Consequently, claims 1-16 and new claim 27 are not anticipated by Heitmann, or rendered obvious in view of the teachings of Heitmann.

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §§ 102 and 103(a), and the issuance of a Notice of Allowance indicating that claims 1-16 and 27 are allowed over the prior art of record.

Should the Examiner believe that a conference would advance the prosecution of this application, the Examiner is encouraged to telephone the undersigned counsel to arrange such a conference.

Date: February 1, 2005

Respectfully submitted,



Catherine M. Voorhees

Registration No. 33,074

VENABLE LLP

P.O. Box 34385

Washington, D.C. 20043-9998

Telephone: (202) 344-4000

Telefax: (202) 344-8300

CMV/elw
DC2/616471